

Appln No. 09/640,963
Amdt date August 20, 2004
Reply to Office action of May 20, 2004

REMARKS/ARGUMENTS

Claims 1-45 will be pending in this application upon entry of the above-amendments. Claims 19 and 20 stand allowed. Claims 1, 3, 8, 13 and 15-18 have been amended. Claims 44-45 have been added. The amendments find full support in the original specification, claims, and drawings. No new matter has been added. In view of the above amendments and remarks that follow, reconsideration and allowance of the now pending claims 1-45 are respectfully requested.

The Official Draftperson objected to the drawings. Applicant will submit formal drawings upon receiving an indication of allowance of the now pending claims.

The Examiner rejected claims 1-18 under 35 U.S.C. 112, first paragraph, because the specification does not reasonably provide enablement for the variables k, i, n, and L recited in the claims. In response, Applicant has replaced each instance of k, i, n, and L in the claims, with respectively "k," "i," "n," and "L," which the Examiner acknowledges are enabled by the specification. Withdrawal of this rejection is respectfully requested.

Applicant notes that the Examiner did not cite any prior art against claims 1-20. Applicant therefore submits that these claims are now in condition for allowance.

The Examiner rejects claims 21-32, and 34-42 under 35 U.S.C. 103(a) as being unpatentable over Van Den Berghe et al. (U.S. Patent No. 6,233,713). Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Van Den Berghe in view of admitted prior art. Claim 43 is objected to as being

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dependent upon a rejected base claim, but the Examiner indicates that it would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicant respectfully traverses these rejections.

With respect to independent claims 21 and 27, they respectively recite "compressing a puncture mask" and "decompressing the compressed puncture mask." The Examiner acknowledges that "Van Den Berghe et al. does not expressly disclose compressing a puncture mask[] as claimed in the pending patent application." The Examiner, however, concludes that "it would have been obvious for one of ordinary skill in the art that the puncture code is equivalently stored in a compressed form in the code book . . ." (Office action, p. 5, lines 6-11).

Applicant respectfully submits that this § 103 rejection is improper. It is well-settled that in order to establish a *prima facie* case of obviousness, the Examiner must show "some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings." M.P.E.P. § 2143. The Examiner here fails to point to any objective evidence that would have motivated one of ordinary skill in the art to electronically store puncture masks by "compressing a puncture mask" and use the puncture masks by "decompressing the compressed puncture mask." Instead, the Examiner makes a broad conclusory statement that it would have been "obvious" to do so. However, such a broad conclusory

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statement, standing alone, is not evidence of a motivation to combine, and therefore cannot support a § 103 rejection.

In fact, Applicant respectfully submits that there is no prior art motivation to modify the Van Den Berghe system in the manner suggested by the Examiner. In particular, Van Den Berghe already provides an approach for efficiently storing puncture codes in memory. This is achieved, not by compressing the puncture codes themselves, but by generating an index to a puncture code, and storing the index in a three dimensional code book. "As a result, the lengthy puncture codes are stored only once, rather than stored in connection with each coding condition in which a particular puncture code is used." (Col. 8, lines 15-19) (Emphasis added). It is clear that in Van Den Berghe, the actual puncture codes are not stored in a compressed format, but rather, in their original "lengthy" format. However, because the index to the puncture codes are stored as often as needed in the code book instead of the actual lengthy puncture code, memory efficiency may nonetheless be achieved.

Furthermore, instead of "retrieving a compressed puncture mask . . . and decompressing the compressed puncture mask" when it is time to use the puncture mask, Van Den Berghe simply teaches retrieving the puncture code index from the code book and reading the actual bits of the corresponding puncture code. (See, Col. 6, lines 30-35):

Therefore, because the Examiner has not provided any objective evidence of a suggestion or motivation to modify Van Den Berghe in the way proposed by the Examiner, Applicant

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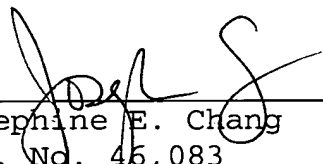
respectfully requests the withdrawal of the § 103 rejection of independent claims 21 and 27.

Applicant also respectfully requests the withdrawal of the § 103 rejection of claims 23-26 and 28-42. Claims 23-26 and 28-42 are in condition for allowance because they depend on an allowable base claim, and for the additional limitations contained therein.

Claims 44-45 are new in this application. Claims 44-45 are also in condition for allowance because they depend on an allowable base claim, and for the additional limitations contained therein.

In view of the above amendments and remarks, reconsideration, reexamination, and an early indication of allowance of the now pending claims 1-45 are respectfully requested.

Respectfully submitted,
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